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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,673	02/26/2001	Michael Fischer	49409	8610

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EXAMINER

THEXTON, MATTHEW

ART UNIT PAPER NUMBER

1714

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/763,673

Applicant(s)

FISCHER ET AL.

Examiner

Matthew A. Thexton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6,8-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,8-10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

Claims 6, 8-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright et al. (EP 0643104-A2, as evidenced by the USPTO obtained translation).

The reference discloses every component of the claims and exemplifies formulations encompassed by the claims except for the component D, glass fibers. The reference suggests glass fibers may be employed in proportions which are encompassed by the claims (page 16, last complete paragraph, and paragraph bridging pages 16-17). Thermoprocessing is disclosed and exemplified.

The physical properties required by claim 12 would be inherent to the obvious formulation when glass fibers are employed as suggested.

Claims 6, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binsack et al. (US 4535124).

The reference discloses formulations which are encompassed by the claims. Examples 24-26 employ polybutylene terephthalate, plus bimodal mixture of rubber based grafted shell-core particles using styrene/acrylonitrile copolymer shell and n-butylacrylate/triallylcyanurate core, plus styrene/acrylonitrile copolymer (column 14, lines 52-55). The glass transition temperature limitation of claim 6 would be inherent to

the core rubber since it is formulated in the same way in the reference as in applicant's disclosure and formulation limitations claimed. Thermoprocessing is disclosed and exemplified. The reference discloses use of glass fibers and in examples 27-29 uses 25 and 30 percent by weight of them. It would have been obvious to one of ordinary skill in the art at the time of the invention to follow the suggestions of the reference to employ glass fibers in examples 24-26 and thereby arrive at claims 6, 12, and 13.

A mixture of polybutylene terephthalate and polyethylene terephthalate as now required in claim 6, is not exemplified, however, such a mixture is suggested (see column 7, line 47, to column 8, line 59, especially column 8, lines 54-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to follow the suggestions of the reference to employ the mixture of polymers and thus arrive at the limitations of claim 7.

The properties required in claim 12 would be inherent to formulations arrived at by following the suggestions of the reference disclosure. While it would not be necessarily expected that all suggested formulations would have all the properties of the claim, it would have been obvious to one of ordinary skill in the art at the time of the invention to discover optimum or workable ranges (e.g., concentrations, temperature, pH, etc.) by routine experimentation, absent evidence of unexpected results.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 6, 8-10, 12, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 10 US 6605665-B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the four required components of the claimed formulations are required as well in the conflicting claims, and there is no evidence that the formulations are patentably distinct from the methods of molding same.

2. Claims 6, 8-10, 12, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6174958. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are more limited by requiring more components, but the present claims are "comprising" and hence do not exclude other components and thus the present claims are a subset of the patented claims and are obvious.

3. Claims 6, 8-10, 12, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6479617. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are more limited by

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requiring more components, but the present claims are "comprising" and hence do not exclude other components and thus the present claims are a subset of the patented claims and are obvious.

#### ***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Binsack et al. (EP 0142675-A1, as evidenced by the USPTO obtained translation) discloses formulations for thermoplastic molding comprising thermoplastic polyester, and particulate grafted rubber having an average diameter of 400 nanometers.

Kodama et al. (US 5093419-A) discloses formulations for thermoplastic molding comprising thermoplastic polyester, particulate grafted rubber having an average particle size of 50 to 5000 nanometers, copolymer of alpha-alkylstyrene/unsaturated nitrile, and conventional additives.

#### ***Response to Amendment***

At page 6 of Applicant's remarks Applicant suggest disclaimer of term with respect to the rejections. The offer by Applicant is not in compliance with 37 CFR 1.130, 1.321, and/or 3.73. Accordingly, the Double Patenting rejections are maintained, with the rejection over 09/889402 now over the issued patent.

#### ***Response to Arguments***

Applicant's arguments filed 2003 November 14 have been fully considered and found partly persuasive, and partly not persuasive.

Arguments with respect to Binsack et al. (US 4535124) are not commensurate in scope with claims 6, 12 and 13. these claims do not require the particulars of claim 8, which the reference does not disclose or suggest.

Applicant's arguments with respect to Seiler et al, Lausberg et al., McKee et al, and further with each other or other references have been fully considered and are persuasive. The rejections based thereon have been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Bright et al. (EP 0643104-A2, as evidenced by the USPTO obtained translation).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Contact Information***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 571-272-1125. The examiner can normally be reached on Monday-Friday, 9:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew A. Thexton  
Primary Examiner  
Art Unit 1714